

REMARKS

Applicants thank Examiner Tucker for conducting the kind and courteous discussion with Applicants' representative, Daniel R. Evans, on March 25, 2005.

During the discussion, Applicants' representative and the Examiner discussed ways for overcoming the outstanding rejections.

The rejection of Claims 1-2, 4, 9-10, 12-17, and 23-26 under 35 U.S.C. §112, second paragraph, as being indefinite is obviated by amendment.

Applicants have amended Claims 1, 2, and 11 in order to remove the phrase "may have a substituent." This phrase has been replaced with the designator "substituted or unsubstituted" prior to each of the respective substituents. Additionally, instances of alleged ambiguity created by the dual terms of "substituent or protecting group" are corrected by specifying "protecting group." Claims 12-16 are canceled upon entry of the amendment. Claims 23-26 are amended so as to clarify the language of the claim. For example, Claim 23 is amended to specify that the method is directed to reducing the activity of an activated coagulation factor X. Claims 24-26 are amended in a manner as recommended by the Examiner on pages 17-18 of the January 25, 2005 Office Action.

It is believed that the claims are now free of indefinite language.

It is kindly requested that the Examiner acknowledge the same and withdraw this rejection.

The rejection of Claims 1-2, 4, 9-10, 17, and 24-26 under 35 U.S.C. §112, first paragraph, for failing to meet the enablement requirement is respectfully traversed.

Applicants note that there are numerous examples in the specification which describe hydrates as well as solvates. Specific examples of hydrates can be found in Examples 1-6, 9-10, 12-8, 20-23, 25-27, 29-30, 32-42, 45-46, 49, 51-54, 57-67, 71, 75-82, 84-88, 90-91, 94-95, 97-102, 104, 106-121, 123-126, 130-132, and 134. Examples describing solvates or

mixed solvates/hydrates are found in Examples: 7 (iPrOH); 24 and 92 (ethylacetate); 47 and 89 (methanol); 48, 69-70, and 72 (CH₃OH/H₂O); 55 (Et₂O/H₂O); 127 and 129 (CH₂Cl₂/H₂O).

It is believed that there are numerous examples described in the present specification, such that the claimed invention is enabled with respect to the term "or solvates thereof."

It is kindly requested that the Examiner acknowledge the same and withdraw this rejection.

The rejection of Claims 1-2, 4, 9-10, and 17 under 35 U.S.C. §102(e) over the disclosure of US Patent 6,660,739¹ (hereinafter referred to as US '739) is respectfully traversed.

The Examiner is correct that the disclosure of US '739 has an effective U.S. filing date of December 24, 1998, which is based on the filing date of U.S. provisional application 60/113,595. However, Applicants claim priority to three Japanese patent applications which antedate the filing date of U.S. provisional application 60/113,595 by about three months.

Therefore, Applicants respectfully request that the Examiner grant Applicants full benefit of priority to Japanese applications: 10-227449, filed August 11, 1998; 10-244175, filed August 28, 1998; and 10-251674, filed September 4, 1998; as Applicants file concurrently herewith English translations of each of the certified copies of the above-noted Japanese patent applications.

Accordingly, US '739 is not available as prior art.

Consequently, it is kindly requested that the Examiner withdraw this rejection.

The rejection of Claims 1, 2, 4, 9, and 10 under 35 U.S.C. §102(b), or in the alternative under 35 U.S.C. §103(a), over the disclosure of U.S. Patent 5,654,305 (hereinafter referred to as US '305) is respectfully traversed.

¹ Applicants note that on page 13 of the January 25, 2005 Office Action Claims 1-2, 4, 9-10, and 17 are rejected under 35 U.S.C. §102(e) over the disclosure of U.S. Patent 6,660,731, which issued to Bebbington et al. It is believed that this is a typographical error as US '731 is directed to pyrazole compounds. Applicants also note that US '739 is listed as reference A on form PTO-892, which was attached to the January 25, 2005 Office Action.

The Examiner has noted on page 14 of the January 25, 2005 Office Action that Example 7 of US '305 describes a substituted piperazine compound. In particular, one piperazinyl nitrogen is substituted by a sulfonyl substituent, while the other piperazinyl nitrogen is substituted by an *ethyl*-pyridin-imidazolyl substituent. That is, US '305 describes a compound in which the pyridin-imidazolyl substituent is tethered to the piperazinyl ring system by an *ethyl substituent*.

This is in contrast to the sulfonyl derivative claimed in Claim 1, in which the linker T¹ connecting Q² and Q³ (see Formula (I) Q¹-Q²-T¹-Q³-SO₂-Q^A) represents a carbonyl group, a methylene group (or methine group), a -C(=NOR¹⁴)- group, or a -C(=N-NHR¹⁴)- group.

First, the compound described in US '305 does not anticipate the claimed sulfonyl derivative.

Second, there is no suggestion contained in US '305 that any other linker other than ethyl could be used. The compound shown in Example 7 of US '305 contains an ethyl linker that is derived from amine compound 2. The Examiner's attention is directed to Scheme 1 at the bottom of column 10, which shows a coupling reaction involving an indole-3-carboxylic acid, BOP-Cl, and amine compound 2. Since the ethyl linker is derived from amine compound 2, and since there is no suggestion to have any other amine compound having a different linker, there can be no suggestion to prepare the sulfonyl derivative as presently claimed. The Examiner's attention is directed to M.P.E.P. §2144.09 under the subheading of "Presence or Absence of Prior Art Suggestion of Method of Making a Claimed Compound May Be Relevant in Determining *Prima Facie* Obviousness." In particular, the Examiner's attention is directed to paragraph 2 which quotes *In re Hoeksema* (158 USPQ 597) which states that "If the prior art of record fails to disclose or render obvious a method for making a claimed compound, at the time the invention was made, it may not be legally concluded that the compound itself is in the possession of the public." Consequently, since US '305 fails to

describe or suggest a method for making a sulfonyl derivative as claimed in Claim 1, there can be no issue of obviousness.

In view of the fact that US '305 does not describe or suggest the sulfonyl derivative as claimed in Claim 1, it is believed that the claimed invention is both novel and unobvious over the disclosure of US '305.

It is kindly requested that the Examiner acknowledge the same and withdraw this rejection.

In view of the amendments to the claims, submission of English translations of the certified copies of the three Japanese priority applications, and the comments contained herein, it is believed that the present application is in a condition for allowance.

It is kindly requested that the Examiner acknowledge the same and pass this application to issue.

Should the Examiner deem that a personal or telephonic interview would be helpful in advancing this application toward allowance, he is encouraged to contact Applicants' undersigned representative at the below-listed telephone number.

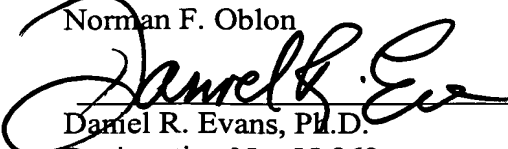
Applicants note that statutory period for reply to the Office Action dated January 25, 2005 expired on April 25, 2005. Accordingly, Applicants file concurrently herewith a request for a three-month extension of time under 37 CFR § 1.136, with the appropriate fee under 37 CFR § 1.17. Should there exist a variance between that which is paid and owed, the Office is authorized to charge deposit account number 15-0030, in order to maintain pendency of the above-identified application.

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)
DRE/rac

Respectfully submitted,
OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Norman F. Oblon



Daniel R. Evans, Ph.D.
Registration No. 55,868